

REMARKS/ARGUMENTS

Initially, Applicant would like to express appreciation to the Examiner for the detailed Official Action provided, for acknowledgement of Applicant's Information Disclosure Statement by return of the FORM PTO-1449, for acknowledgement that the drawings are acceptable, and for acknowledgement of Applicant's Claim for Priority and receipt of the certified copy of the priority document.

Upon entry of the above amendments, claims 1-13 will have been amended, and claims 14-20 will have been added. Claims 1-20 are currently pending. Applicant respectfully requests reconsideration of the outstanding rejections, and allowance of all the claims pending in the present application.

In the Official Action, the Examiner rejected claims 1, 3, 8, 9 and 10-13, under 35 U.S.C. § 102(b) as being anticipated by HOFFMAN et al. (U.S. Patent No. 5,021,056).

Applicant respectfully traverses the above noted rejection of 1, 3, 8, 9 and 10-13, under 35 U.S.C. § 102(b).

Initially, Applicant submits that claims 1-13 have been amended solely in order to more clearly recite the present claimed invention, i.e., the amendments are *cosmetic* in nature and no estoppel should be deemed to apply. In this regard, Applicant notes that HOFFMAN fails to teach or suggest the combination of elements as recited in claim 1. In particular, claim 1 sets forth a device for ligament reconstruction including, inter alia, a connector which connects said rear-end and said tip, wherein said connector has a single connection hole

connecting one of said through-holes of said tip portion coaxially to one of said through-holes of said rear- wherein said connector is thinner and longer than said tip and said rear-end, and wherein said tip has a generally elliptical or rectangular cross section elongated in a direction in which said through-holes thereof are juxtaposed.

Applicant submits that HOFFMAN lacks any disclosure of the aforementioned combination of elements.

In this regard, the Examiner asserts that HOFFMAN discloses the present claimed device for ligament reconstruction. More particularly, the Examiner considers the tip, as purportedly disclosed in HOFFMAN, to be the entire end of the device, including elements 54 or 46 (which the Examiner considers to be the generally rectangular or generally elliptical cross-sections, respectively). However, even assuming, arguendo, that the Examiner could properly consider the end portion of the device of HOFFMAN (as indicated on Page 3 of the Official Action) to be a tip, the cross-section (as purportedly disclosed in HOFFMAN) would be comprised of several geometrical cross-sections having different dimensions. In other words, the tip of HOFFMAN would have an irregular shaped cross-section which would include the cross-sections of elements 54, 46 and 22. Thus, HOFFMAN does not disclose the tip having a generally elliptical or rectangular cross section elongated in a direction in which the through-holes thereof are juxtaposed, as recited in claim 1.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35

U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claim 1, as well as claims 2-13 (and newly added dependent claim 14) depending therefrom, these claims are not anticipated thereby. Further, all pending dependent claims recite additional features that further define the present invention over the prior art. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102 and allow all pending claims in the present application.

In the Official Action, the Examiner has rejected claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over HOFFMAN.

Applicant respectfully traverses the above noted rejections of claims 1-13 under 35 U.S.C. § 103(a).

Initially, Applicant notes that claims 1, 3, 8, 9 and 10-13 are listed among the claims rejected under 35 U.S.C. § 103(a). However, the Examiner has not addressed their respective recitations as they pertain to the rejection under 35 U.S.C. § 103(a). That is, it appears that the Examiner intends to reject dependent claims 2, 4, 5, 6 and 7 under 35 U.S.C. § 103(a). Accordingly, Applicant respectfully requests that the Examiner clarify which claims have been rejected under 35 U.S.C. § 103(a).

Further, in regard to claims 2, 4, 5, 6 and 7, the Examiner acknowledges that HOFFMAN does not disclose the combination of elements recited therein. Nevertheless, the Examiner asserts that the combination of elements recited therein (i.e., claims 2, 4, 5, 6 and 7) only involve discovering obvious optimum or workable ranges. However, Applicant submits that the Examiner has provided no

factual evidence to support his assertion. Further, if the Examiner decides to maintain the aforementioned rejection of claims 2, 4, 5, 6 and 7, Applicant respectfully requests that the Examiner provide an appropriate teaching reference indicating the same.

Further, Applicant submits that dependent claims 2, 4, 5, 6 and 7, are at least patentable due to their dependency from claim 1 for the reasons noted above. In this regard, Applicant notes that the Examiner has provided no explanation or motivation for correcting the above-noted deficiencies in the teachings of HOFFMAN. Applicant further submits that the Examiner's assertion that the combination of elements recited in claims 2, 4, 5, 6 and 7, only involve discovering obvious optimum or workable ranges, does not provide any teachings which could reasonably be characterized as curing the above-noted deficiencies in the teachings of HOFFMAN. In this regard, Applicant submits that HOFFMAN, alone or in any proper combination, does not disclose the tip having a generally elliptical or rectangular cross section elongated in a direction in which the through-holes thereof are juxtaposed, as recited in claim 1.

Further, the Examiner is reminded that "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). In this regard, Applicant submits that the Examiner has made no such showing.

Accordingly, the Examiner is respectfully requested to withdraw the

rejection under 35 U.S.C. § 103, and allow all pending claims in the present application.

In the Official Action, the Examiner has rejected claim 1 of the present application under the doctrine of nonstatutory double patenting as being unpatentable over claim 1 of co-pending Application No. 10/563,915 (Appl. No. '915).

Applicant respectfully traverses the above-noted double patenting rejection. In this regard, Applicant submits that claim 1 of co-pending Appl. No. '915 does not recite *a connector being thinner and longer than both the tip and the rear-end*. Further, the Examiner has not explained why the claims are not patentably distinct from one another. That is, the Examiner has not provided an appropriate secondary teaching reference or otherwise indicated why at least the above-noted feature is not a patentable distinction. Accordingly, the Examiner is respectfully requested to withdraw the non-statutory double patenting rejection, and allow all pending claims in the present application.

Applicant further submits that new independent claim 15, is generally similar to independent claim 1 in that it recites, inter alia, a tip having either one of a generally rectangular or generally elliptical cross-section, wherein said tip has generally parallel first and second tip through-holes formed in juxtaposition inside of said rectangular or elliptical cross-section. Accordingly, claim 15 (as well as claims 16-20) is allowable for at least reasons generally similar to claim 1, as discussed above.

In view of the arguments herein, Applicant submits that independent

claims 1 and 15 are in condition for allowance. With regard to dependent claims 2-14 and 16-20, Applicant asserts that they are allowable on their own merit, as well as because of their respective dependencies from independent claims 1 and 15, which Applicant has shown to be allowable.

Thus, it is respectfully submitted that all of the claims in the present application are clearly patentable over the references cited by the Examiner, either alone or in combination, and an indication to such effect is respectfully requested, in due course.

SUMMARY

Applicant submits that the present application is in condition for allowance, and respectfully requests an indication to that effect. Applicant has argued the allowability of the claims and pointed out deficiencies of the applied reference. Accordingly, reconsideration of the outstanding Official Action and allowance of the present application and all the claims therein are respectfully requested and is now believed to be appropriate.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. The amendments to the claims have not been made for a purpose related to patentability, but rather are clarifying amendments that are cosmetic in nature, *i.e.*, for easier reading. The amendments to the claims should thus be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. Accordingly, this amendment should not be considered a decision by Applicant to narrow the claims in any way.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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